

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 1-16 are currently pending in this application. No new matter has been added by way of the present amendment. For instance, claims 9 and 10 have been rewritten in independent form, as suggested by the Examiner. Claims 8 and 13 have been amended to correct various informalities identified by the Examiner. Accordingly, no new matter has been added.

At the outset, the present application is believed to be in condition for allowance. Entry of the accompanying amendment is requested under 37 C.F.R. §1.116, as the amendment does not raise any new issues which would require further search and/or consideration by the Examiner. Furthermore, Applicants request entry of this amendment in order to place the claims in better form for consideration on Appeal.

In view of the amendments and remarks herein, Applicants respectfully request that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

Issues Under 35 U.S.C. 112, second paragraph

Claims 8 and 13 stand rejected under 35 U.S.C. 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. Applicants respectfully traverse.

The Examiner asserts that claims 8 and 13 are improper dependent claims, and fail to further limit the claims on which they depend.

Applicants submit that claims 8 and 13 have been amended to correct the informalities identified by the Examiner. Accordingly, this rejection is moot.

Reconsideration and withdrawal of this rejection are thus respectfully requested.

Issues Under 35 U.S.C. § 103(a)

Claims 1-8 and 11-16 stand rejected under 35 U.S.C. §103(a) as obvious over Tanimoto et al. (U.S. 6,562,817) (hereinafter Tanimoto '817). Applicants respectfully traverse.

The Examiner maintains his previous position that Tanimoto '817 discloses several tricyclic compounds for use in organ transplant, "which include instant compounds". The Examiner acknowledges that Tanimoto '817 differs from the instant claims "in exemplifying pyrimidine compounds having O-benzyl group for X-Y and other groups hydroxyl, sulfonyl etc as substituents". The Examiner, however, asserts that it would have been obvious to one skilled in the art to "make compositions using the teachings of Tanimoto et al... and expect resulting composition to possess the uses taught by the art".

In response to our previous arguments, the Examiner asserts that Tanimoto '817 "exemplifies large number compounds including those with allyloxy substituents, and thereby provides guidance for choosing substituents. Thus, there is motivation to make the compounds of the genus as one would expect the genus would share the same use as those exemplified compounds".

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, there must be a reason why one of ordinary skill in the art would modify the reference or combine reference teachings to obtain the

invention. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The Supreme Court of the United States has recently held that the "teaching, suggestion, motivation test" is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

As previously noted, Tanimoto '817 discloses tricyclic compounds used as immunosuppressants, anti-allergic agents or suppressants of IgE production. The present invention is directed to pyrimidines that are suitable active ingredients for crop protection. Consequently, the skilled person who wants to find new fungicidally active compounds would not look at the teachings of Tanimoto '817 or take this reference into account at all. For this reason alone, the present rejection is improper and should be withdrawn.

Furthermore, even if one skilled in the art were to consider the teachings of Tanimoto '817 (a point which Applicants do not concede), the skilled artisan would not arrive at the present invention, as Tanimoto '817 does not provide any guidance as to which compounds to choose from an extremely long list of compounds disclosed, or how to modify these compounds so as to obtain the fungicidally effective compounds presently claimed.

The Examiner is respectfully reminded that the fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of

obviousness. *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994). The compound disclosed by Tanimoto '817 includes a ring "B", which can be one of **several hundred choices** (emphasis added), including an optionally substituted pyrimidine ring. The Examiner's attention is directed to columns 109-208 of Tanimoto '817, wherein hundreds of examples are disclosed. Specifically, as shown in columns 115-121 and 149-151, when ring "B" is pyrimidine (identified as "S3" on Table 56 and subsequent Tables), and ring "C" is a heterocycle, the substituted phenyl ring "A" is substituted by OH and benzyloxy, and OMs and benzyloxy (see compounds If-11, 12, 15, 16, 23, 24, 27 and 28 in Table 86, all of which require "A32" or "A33"; see also Table 50 for the definition of "A32" and "A33"). Applicants submit that, in the novel compound of the present invention, the 5-phenyl ring **does not carry** (emphasis added) "OH" or "OMs" groups.

Compounds If-9, 10, 13, 14, 21, 22, 25 and 26 of Tanimoto '817 are even further removed from the novel compound of the present invention, as they additionally require an O-benzyl substituent in the 5-phenyl ring. Additionally, Tanimoto '817 does not provide any guidance or information as to possible modifications of the 5-phenyl substituent.

Evidently, the cited reference fails to render the present invention obvious. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

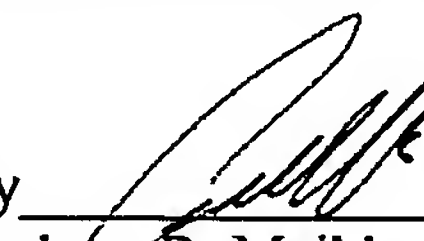
All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Andrew D. Meikle, Reg. No. 32,868 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 
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